

REMARKS/ARGUMENTS

Claims 10-11 and 35 are pending. Claims 1-6 and 12-34 are withdrawn from consideration and have been canceled. Claims 7-9 also are canceled and claims 10-11 stand rejected.

Claims 10 and 11 have been amended. Claim 10 has been made independent and the recitation of SEQ ID: 22 has been removed from claims 10 and 11. New claim 35 has been added to recite the substance of what was removed from claim 11.

Claims 7-9 were rejected under 35 U.S.C § 112, first paragraph, for lack of written description. Applicant has cancelled claims 7-9 herein rendering this rejection moot.

Claims 7-11 were rejected under 35 U.S.C § 101 for lack of utility. Claims 7-11 also were rejected under 35 U.S.C. § 112, first paragraph for essentially the same reason. The section 112 rejection contends that since a utility is not provided a skilled worker would not know how to use the invention. These rejections are respectfully traversed.

As noted, Claims 7-9 are cancelled herein.

To support the utility of amended claims 10 and 11, the specification needs one credible assertion of a specific utility for the claimed invention to satisfy 35 U.S.C. § 101. *Raytheon v. Roper*, 724 F.2d 951, 958, 220 U.S.P.Q. 592, 598 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984) (“When a properly claimed invention meets at least one stated objective, utility under 35 U.S.C. 101 is clearly shown. Unless there is reason to doubt the asserted utility, Applicants are entitled to a presumption that the asserted utility is sufficient to satisfy 35 U.S.C. § 101:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope (emphasis added).

In re Langer, 503 F.2d 1380, 1391 183 U.S.P.Q. (BNA) 288, 297 (C.C.P.A. 1974). To overcome the presumption that Applicants' asserted utility is true, the Examiner must establish by a preponderance of the evidence that it is more likely than not that one of ordinary skill in the art would question the truth of the statement of utility. M.P.E.P. § 2107.2(III)(A).

The application provides a credible assertion of a specific utility, while the Office Action does nothing more than assert that "the present invention does not disclose a specific and substantial activity." (rejection page 5)

The specification teaches that the polypeptides of SEQ IDs 18, 20 and 22 may be used to test for inhibitors and activators of' BCA-GPCR3 (See Specification page 44-45) useful in the modulation of signaling pathways in, for example, breast cancer. Moreover, applicant has noted that "subsequences [represented by SEQ IDs, 18, 20 and 22] have comparable functional activity to the [full length] BCA-GPCR3 polypeptide" (Specification, page 9. last full paragraph)

The Examiner has not provided the required proof to establish by a preponderance of the evidence that it is more likely than not that one of ordinary skill in the art would question the truth of the statement of utility and withdrawal of this rejection is respectfully requested.

Furthermore, the uses described above and the indication of comparable activity with the full length activity would also enable one of skill in the art to use the claimed invention. Thus, Applicant also respectfully requests withdrawal of the related utility/enableness rejection, under 35 U.S.C. § 112 1st paragraph.

Applicant respectfully asserts that the objections to the title and disclosure have been overcome by removing the word 'novel' from the title and deleting the embedded hyperlink.

The drawings supplied on 12/20/2001 were objected to by the Office. Replacement pages are submitted herewith in which tables and figures are identified correctly. Amendments to the specification have been made to reflect the changes in the labels of the drawings. Applicant respectfully asserts that the objections to the drawings have been overcome.

Claims 7-10 were rejected under the judicially created doctrine of obviousness-type doubling patenting. This rejection is respectfully traversed. A terminal disclaimer is enclosed. The owners of this application and U.S. Patent are the same, as evidenced by the recordation of the assignment at reel/frame 015886/0268, recorded April 11, 2005.

No new matter has been added by means of these amendments. Consideration and formal allowance of the elected claims thus are respectfully requested.

Respectfully submitted,

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